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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,426	03/18/2004	Jerry R. Grychowski	6298/453	5532

7590 09/19/2005

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EXAMINER

ALI, SHUMAYA B

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 09/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/803,426	Applicant(s) GRYCHOWSKI ET AL.	
	Examiner Shumaya B. Ali	Art Unit 3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☒ Claim(s) 6,7,11,18,20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>detailed action</u> . |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,4,7,9,10,18,19,25, 26,57 and 62 of U.S. Patent No.5, 823,179 in view of Ryder US Patent 5,533,497.

3. As to claims 1,10, and 19 all limitations are recited in claims 1,7, and 10 of '179 except for a cover removably mounted on said housing and the cover comprises a circular cross-section. However, a circular cover member removably mounted on a housing is well known in the art. Ryder teaches a aerosolization device with a removable cap 20 on a housing 15 which is considered to have circular cross section, see fig.1 Therefore, it would have been obvious to one of ordinary skills in the art at the time the invention was made to add a removable cap to the invention of the applicant for the purposes of providing a seal which reduces the quantity of air aspirated from the minimal space, with improved aerosol output (see abstract of '497).

4. Claim 2 is recited in claim 9 of '179 and claim 3 is considered broadly recited under claim 9 of '179.

5. Claims 4,5, 9,13,14, 22, 23, and 30 are respectively recited in claims 19, 25, 62,1 and 10,7, 1 and 26, 4, and 18 of '179

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6. Claim 8 is considered broadly recited under claim limitation "chamber" in claim 1 of '179; claims 24-25 are broadly recited under claims 1, 4, and 26 of '179; claims 27 -29 are considered broadly recited under claim 57 of '179

7. Claims 15 -17 are considered broadly recited under "outlet " in claim 1 of '179. As to claim 16, it is well known in the art that the diameter of the circular shape can come in various sizes and shapes. Since the applicant has not established criticalities why the diameter size is critical to the invention, therefore it would have been obvious to one of ordinary skills in the art to consider the diameter of the circular end as a matter of design choice.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 6,7,11,18,20, and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims are considered indefinite because following limitations "a hollow protrusion" claim 6 and 7, "cover comprises an outer diameter greater than an outer diameter of said housing" claim 11, "a longitudinal axis" claim 18, "outlet is integrally formed" claim 20, "flexible membrane is secured to said cover" claim 26 may be lacking proper antecedent basis in the specification. Applicant is suggested to point out where in the specification those limitations are disclosed in order for the claims to be considered on the merit. Claims as recited above (6,7,11,12,18,20,26) and any claims depended from them (12,19,21) will not be examined since it is unclear how those limitations fit into the invention as a whole is unclear from the disclosure.

Specification

10. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claims 6,7,11,18,20, and 26 are objected to for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims are considered indefinite because following limitations "a hollow protrusion" claim 6 and 7, "cover comprises an outer diameter greater than an outer diameter of said housing" claim 11, "a longitudinal axis" claim 18, "outlet is integrally formed" claim 20, "flexible membrane is secured to said cover" claim 26 may be lacking proper antecedent basis in the specification. Applicant is suggested to point out where in the specification those limitations are disclosed in order for the claims to be considered on the merit. Claims as recited above (6,7,11,12,18,20,26) and any claims depended from them (12,19,21) will not be examined since it is unclear how those limitations fit into the invention as a whole is unclear from the disclosure.

Drawings

11. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "a hollow protrusion" claim 6 and 7, "cover comprises an outer diameter greater than an outer diameter of said housing" claim 11, "a longitudinal axis" claim 18, "outlet is integrally formed" claim 20, "flexible membrane is secured to said cover" claim 26. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is

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being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Information Disclosure Statement

12. Copies of the foreign references and non-patent literature cited in the PTO-1449 not found.

Conclusion


13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US 4,251,033 depicts a cap **35** larger in diameter than a chamber **30** it is secured to, see fig.2.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shumaya B. Ali whose telephone number is 571-272-6088. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Shumaya B Ali
Examiner
Art Unit 3743
9/14/05


Henry Bennett
Supervisory Patent Examiner
Group 3700